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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/019,684 | 01/04/2002 | Robert P. Schnall | 01/22882 | 7802 |
| 7590 | 06/29/2004 | | EXAMINER | |
| G E Ehrlich (1995) LTD c/o Anthony Castorina 2001 Jefferson Davis Highway Suite 207 Arlington, VA 22202 | | | NASSER, ROBERT L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3736 | |
| DATE MAILED: 06/29/2004 | | | | |

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Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/019,684 | SCHNALL, ROBERT P. |
| | Examiner | Art Unit |
| | Robert L. Nasser | 3736 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) 1-34 is/are rejected.
- 7) Claim(s) ____ is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 - Certified copies of the priority documents have been received in Application No. ____.
 - Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 4.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date ____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: ____.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-5 and 25-31 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-5 and 26-31 of prior U.S. Patent No. 6488633. This is a double patenting rejection. The claims are not identical, but they are merely slightly differently worded versions and are drawn to the same patentable invention.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 6-24 and 32-34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 6488633. Although the conflicting claims are not identical, they are not patentably distinct from each other because the current claims are broader (a chamber versus one or more chambers) versions of the previous claims, and, as such, are covered by the previous claims.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 56 and 57 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims recite that the joint or hinge and the actuator are located outside of the body. The human body is non-statutory and cannot be positively recited. Therefore, the claim is non-statutory. Applicant can overcome this rejection by reciting that the joint is adapted to be actuated from outside the body, for example.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 32 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Muz. Muz shows a device having a housing 1 for receiving a patient's body part, having a distal section including bladder 7 and a proximal

section without the bladder, pressurizing means 5, that are equivalent to applicant's, for pressurizing the distal section, and sensor 15 and 17, where the proximal end section includes a soft elastic silicon rubber inner wall. Applicant on page 13, line 18 of the specification states that a sponge cushion may be made from a sponge rubber or the like. It is the examiner's position that a soft, elastic silicon rubber wall a "sponge rubber or the like."

Claims 1, 2, 25, 26, and 30-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldberger et al. Goldberger et al shows a device including a housing 10 for receiving a finger, where the housing has three contiguous portions, a distal portion of members 70 and 80, that is distal to the sensor (right in figure 3), a middle portion housing the sensor and a proximal portion proximal to the sensor (to the left in figure 3), where the device includes means 40 to apply a pressure to the distal portion. The examiner notes that the device has a length sufficient to cover 2 phalanges and its length is "approximately 50 mm.

Claims 3-24, 27, 28, and 29 would be allowable if the double patenting rejection were overcome and if they were rewritten to include the limitations of the base claim and any intervening claims. Claims 3-24 define over the art of record in that none of the art has 3 contiguous chambers, as recited, where the pressurizing means is formed of a deformable membrane means, as claimed.

Claims 27 and 28 define over the art in that none of the art has two sensors, one in the middle and one in the proximal sections. Claim 29 defines over the art in that none of the art has the claimed air vents.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Schnall 6,461,305, Kiani-Azarbajany et al, and Edmark et al all show similar devices to the claimed invention.

Goor shows a device with three chambers, C1, C2, and C3, but since two of the chambers are coextensive, there is not a proximal, middle and distal chamber.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert L. Nasser whose telephone number is (703) 308-3251. The examiner can normally be reached on Mon-Fri, variable hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (703) 308-3130. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert L. Nasser
Primary Examiner
Art Unit 3736

RLN
June 21, 2004



ROBERT L. NASSER
PRIMARY EXAMINER